

REMARKS

Claims 1-16 were examined and reported in the Office Action. Claims 1-16 are rejected. Claims 1 and 9 are amended. Claims 1-16 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. 35 U.S.C. §102(e)

It is asserted in the Office Action that claims 1-6 and 9-14 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,655,020 issued to Powers ("Powers"). Applicant respectfully disagrees.

According to MPEP §2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990))."

Applicant's amended claim 1 contains the limitations of "[a] method of processing confidential codes in a system having secure functions (180), the method comprising the steps consisting in: - receiving a code; - verifying a first entitlement as determined by a first code for a first function (180) providing full transaction rights access; - authorizing access to the first function (180) if the first entitlement is recognized; and - if the first entitlement is not recognized, using the code to verify a second entitlement as determined by a second code that is different from the first code, to trigger at least one second function (170) providing reduced or altered transaction rights without revealing the fact that the code does not make it possible to obtain the first entitlement; the method being characterized in that the step of verifying the second

entitlement comprises the operations consisting in: obtaining a new code from the received code by means of a second transformation (140) that is the inverse of a first simple transformation that enables the holder of the first code to obtain the second code from the first code; and testing the new code by performing again the step of verifying the first entitlement."

Applicant's amended claim 9 contains the limitations of "[a]pparatus for controlling access to secure functions (180) by means of a code, the apparatus comprising: - means for receiving a code; - means for using said code to verify a first entitlement as determined by a first code for accessing a first function (180) providing full transaction rights ; - means for authorizing access to the first function (180) if the entitlement is recognized; and - if the first function (180) is refused, means for using the code to verify a second entitlement as determined by a second code which is different from the first code in order to trigger at least one second function (170) providing reduced or altered transaction rights without revealing the fact that the code does not enable the first entitlement to be obtained; the apparatus being characterized in that the means for verifying the second entitlement perform operations consisting in obtaining a new code from the received code by means of a second transformation (140) that is the inverse of a first simple transformation that enables the holder of the first code to obtain the second code from the first code, and executing again the step of verifying the first entitlement in order to test the new code."

Applicant's claimed invention features entry of a first or a second code that respectively gives full or restricted (or suppressed) access rights. The full access rights will, for example, be the maximum available amount allowed by the cash dispenser, while the restricted amount will, for example, be a reduced amount of cash or even a non-distribution message.

Powers discloses an authenticating method that requires entry of two different codes, the second code being derived from the first by the user (himself/herself) before entry on the basis of a simple alteration, which is expected by the machine. The expected alteration is verified by the machine in order to authenticate the user and finally give a unique access to particular rights. Nowhere in Powers, however, are two

types of functions disclosed, one being triggered by a first code and giving full access to related rights, while the second function is triggered by the second code and gives a reduced or altered access. In other words, nowhere does Powers disclose a selective entry of one code or the other, depending on which a full access or a reduced or altered access is allowed.

Applicant's claimed invention also specifies that the checking step for verifying the second entitlement by obtaining a new code from the inputted code by means of a transformation that is the reverse of a first simple transformation enabling the holder of the first code to deduce in his mind the second code from the first code; the step of checking of the second entitlement further includes testing the code by performing again the step of verifying the first code-based entitlement on this reversed code. This method is simple to implement since there is one single verification scheme for the two types of entitlement directly into the system.

Distinguishable, Powers does not disclose a reverse transformation so as to implement the same verification scheme as would be implemented if the original code (first code) had been entered. Powers, on the contrary checks the link between two inputted codes that are both taken into account. Therefore, the method disclosed by Powers specifically aims at providing a double checking method for a given entitlement while Applicant's claimed invention provides means for selectively obtaining first (full) entitlement or second (reduced or altered) entitlement depending on the inputted code, while sharing a common verification scheme either on the first code as inputted or on the first code as obtained by reverse transformation of the second code.

Thus, Powers does not disclose, teach or suggest the limitations contained in Applicant's amended claims 1 and 9, as listed above. Since Powers does not disclose, teach or suggest all of Applicant's amended claims 1 and 9 limitations, as listed above, Applicant respectfully asserts that a prima facie rejection under 35 U.S.C. §102(e) has not been adequately set forth relative to Powers. Thus, Applicant's amended claims 1 and 9 are not anticipated by Powers. Additionally, the claims that directly or indirectly depend from claims 1 and 9, namely claims 2-6 and 10-14, respectively, also are not anticipated by Powers for the same reason.

Accordingly, withdrawal of the 35 U.S.C. §102(e) rejections for claims 1-6 and 9-14 is respectfully requested.

I. 35 U.S.C. §103(a)

It is asserted in the Office Action that claims 7-8 and 15-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Powers and further in view of U. S. Patent No. 4,774,500 issued to Lichty ("Lichty"). Applicant respectfully disagrees.

According to MPEP §2142 "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (In re Vaeck, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991)). Further, according to MPEP §2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." "*All words in a claim must be considered* in judging the patentability of that claim against the prior art." (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant's claims 7-8 directly or indirectly depend from amended claim 1. Applicant addresses Powers regarding claim 1 above in section I. Applicant's claims 15-16 directly or indirectly depend from amended claim 9. Applicant addresses Powers regarding claim 9 above in section I.

Lichty discloses A data compaction method for writing data in compact binary form. The data compaction method is suitable for an account card having a limited, non-erasable memory used in an automated transaction terminal for maintaining an account record of transactions in frequently recurring amounts. A postage metering terminal is operated by the account card, in which an initial balance has been written

and each purchase of postage is recorded. A current balance is recomputed by parsing the previously recorded data. If the current balance is sufficient, the requested value is recorded in compressed form in the card memory, and the terminal is operated to print or dispense the requested postage.

Nowhere in Lichty, however, are two types of functions disclosed, one being triggered by a first code and giving full access to related rights, while the second function is triggered by the second code and gives a reduced or altered access. Therefore, Lichty does not disclose a selective entry of one code or the other, depending on which a full access or a reduced or altered access is allowed. Further, Lichty does not disclose a reverse transformation so as to implement the same verification scheme as would be implemented if the original code (first code) had been entered.

Therefore, even if the teachings of Powers were combined with that of Lichty, the resulting invention would still not contain all of the limitations of Applicant's amended claims 1 and 9. Since neither Powers, Lichty, nor the combination of the two disclose, teach or suggest all the limitations contained in Applicant's claims 1 and 9, as listed above, there would not be any motivation to arrive at Applicant's claimed invention. Thus, Applicant's claims 1 and 9 are not obvious over Powers in view of Lichty since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from claims 1 and 9, namely claims 7-8, and 15-16, respectively, are also not obvious over Powers in view of Lichty for the same reason.

Accordingly, withdrawal of the 35 U.S.C. §103(a) rejections for claims 7-8 and 15-16 are respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that claims 1-16 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on November 21, 2003, Applicant respectfully petitions the Commissioner for a three (3) month extension of time, extending the period for response to FRIDAY, MAY 21, 2004. The Commissioner is hereby authorized to charge payment to Deposit Account No. 02-2666 in the amount of \$950.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(3) large entity. A duplicate of Applicant's Fee Transmittal is enclosed.

Respectfully submitted,

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Dated: May 21, 2004

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on May 21, 2004.


Jean Svoboda